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JUL 15 2011

OFFICE OF PETITIONS

In re Patent No. 7,935,123	: DECISION ON REQUEST
Issued: May 3, 2011	: FOR RECONSIDERATION
Application No. 10/664,575	: OF PATENT TERM ADJUSTMENT
Filed: September 17, 2003	: AND
Attorney Docket No. DEP5150USCIP1	: NOTICE OF INTENT TO ISSUE
	: CERTIFICATE OF CORRECTION

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(d) AFTER PATENT ISSUANCE filed July 5, 2011. Applicant requests that the determination of patent term adjustment be corrected from 1301 days to 1270 days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **ONE THOUSAND ONE HUNDRED SIXTY-SEVEN (1167)** days.

Patentees are given **THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer**, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On May 3, 2011, the above-identified application matured into U.S. Patent No. 7,935,123 with a patent term adjustment of 1301 days. On July 5, 2011, Patentees submitted the instant application. Patentees disclose that the patent term adjustment of 1301 days indicated on the front of the patent is incorrect.

Applicants argue that in response to a Final Office Action mailed on November 17, 2006, they filed an amendment on January 16, 2007 under 37 C.F.R. § 1.116 and further, in response to an Advisory Action mailed March 20, 2007, on March 20, 2007, filed a Notice of Appeal, along with a Request for Extension of Time for one month. Applicants argue that the period of delay between when the statutory period of three months expired and when the Notice of Appeal was filed was 31 days in accordance with 37 CFR 1.704.

In this instance, as the amendment filed January 16, 2007 was not in compliance with § 1.113(c), the period for reply to the final rejection continued to run. The proper reply, a Notice of Appeal, was not received in the Office until March 20, 2007. The filing of the Notice of Appeal on March 20, 2007 is considered a failure to engage under 1.704(c)(8). Pursuant to § 1.704(b), the patent term adjustment should have been reduced by 31 days for applicant delay from February 17, 2007 to March 20, 2007, the date of filing of a reply in compliance with §1.113(c). 31 days delay is being entered for Applicant delay.

However, in view thereof, since the Office Action mailed July 2, 2007 was mailed within 4 months of the filing date of the notice of appeal on March 20, 2007, the 47 day delay accorded the Office was incorrect. 47 days delay will be removed from Examination delay.

Applicants argue further that after the filing of the Request for Continued Examination (RCE) and Information Disclosure Statement (IDS) on February 16, 2010, a Supplemental IDS was filed on May 6, 2010 and thus Applicants should have received a reduction in the amount of 79 days.

Applicant's arguments have been considered. Pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. In this instance, the filing of the second IDS on May 6, 2010 is considered a failure to engage under 1.704(c)(8). The record does not support a conclusion that the IDS was expressly requested by the examiner and neither did the IDS include a 1.704(d) statement. Thus 79 days of Applicant delay is being entered.

In the previously filed petition August 17, 2010, applicants argued, in view of the successful appeal decision by the Board of Patent Appeals and Interferences, an entitlement to a patent term adjustment of 23 days for the period from the filing of the notice of appeal on March 20, 2007 to the date of the pre-appeal panel decision on April 11, 2007. The decision mailed March 31, 2011 advised that in view of the Pre-Appeals Conference Decision of April 11, 2007 which withdrew the Final Office Action mailed November 17, 2006 and issued a non-Final Office Action, the amendment filed January 16, 2007 was treated as if filed after non-Final. In such case the subsequent Notice of Appeal is not treated as a supplemental reply given that it was required by the improper Final OA thus, the Notice of Appeal filed on March 20, 2007 does not put PTA time "on hold" and the calculation for the period from March 20, 2007 to the date of the Pre-Appeals Conference Decision of April 11, 2007 in the amount of 23 days, should have been attributed to the Office for Examination delay. 23 days of Examination delay is being entered.

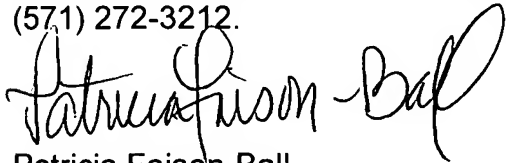
As to the "B" delay, the period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). An appeal to the Board of Patent Appeals and Interferences commences with the filing of a notice of appeal. See 35 U.S.C. 134(a). Generally, an appeal to the Board of Patent Appeals and Interferences ends with either 1) a Board decision, 2) the examiner reopening prosecution and issuing another Office action, or 3) the applicant filing a request to withdraw the appeal and reopen prosecution (e.g. the filing of a request for continued examination). In this instance, there are two periods consumed by appellate review, beginning on March 20, 2007 (filing of notice of appeal) to July 2, 2007 (mailing of non-Final Office Action) and from March 27, 2008 (filing of second notice of appeal) to September 4, 2008 (non-final office action issued), which are not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii). The Office has also determined that the period of overlap is 21 days. Thus, B delay is 721 days, considering the 21 days of overlap.

As such, the patent term adjustment is 1167 (602 "A delay" days + 721 "B delay" days - 21 days of overlap - 135 Applicant delay days) days, not 1270 days.

The \$200.00 fee set forth in 37 CFR 1.18(e) for reconsideration of the Patent Term Adjustment was previously charged to deposit account no. 10-0750 with the decision of the August 17, 2010 petition.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3212.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

DRAFT
UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,935,123 B2

DATED : May 3, 2011

INVENTOR(S) : Jonathan Fanger

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (1301) days

Delete the phrase "by 1301 days" and insert – by 1167 days--